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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

071469-0307692

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Signature _____

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Application Number

10/817,417

Filed

March 30, 2004

First Named Inventor

YUE et al.

Art Unit

1765

Examiner

Chen, Kin, Chan

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record. 44,482
Registration number _____

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____


Signature
John P. Darling

Typed or printed name

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Telephone number

August 15, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

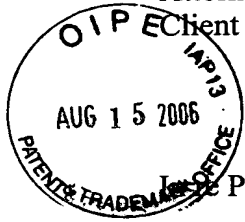
☒ *Total of 1 forms are submitted.

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Attorney Docket: 071469-0307692

Client Reference: RAJ-024



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR'S PATENT APPLICATION of:

Confirmation Number: 1294

YUE et al.

Application No.: 10/817,417

Group Art Unit: 1765

Filed: March 30, 2004

Examiner: Chen, Kin Chan

Title: METHOD AND SYSTEM FOR PERFORMING A CHEMICAL OXIDE REMOVAL PROCESS

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Further to the Notice of Appeal filed herewith, Applicants respectfully request review of the following grounds of rejection: 1) claims 1-6, 8 and 9 under 35 U.S.C. § 102(e) over Tomoyasu et al. (U.S. Patent Application Publication 2004/0185583 A1) as evidenced by Wadsworth; and 2) claims 1 and 4-6, 8 and 9 under 35 U.S.C. § 103(a) over Natzle et al. (U.S. Patent Application Publication 2004/0097047 A1) as evidenced by Wadsworth; and 3) claims 2 and 3 under 35 U.S.C. § 103(a) over Natzle et al. in view of Doris et al. (U.S. Patent Application Publication 2004/0241981 A1).

The undersigned invites the panel to review the arguments presented on page 6-8 of the May 10, 2006 response.

With respect to the Examiner's new "evidence," i.e. Wadsworth, it is respectfully noted that MPEP § 706.02(j) states: "Where a reference is relied on to support a rejection, whether or not in a minor capacity, that reference should be positively included in the statement of the rejection." This is the mandate of 35 U.S.C. § 103(a), which requires consideration of the subject matter as a whole.

The requirements for establishing a *prima facie* case of obviousness are clearly and precisely set forth in MPEP § 2143, which states: "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or

motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”

As acknowledged by the Examiner, Tomoyasu et al. do not disclose or suggest all the claim limitations, in particular the relationships recited in claims 1, 8 and 9. The Examiner’s conclusion that “it would have been obvious to one with ordinary skill in the art to apply commonly used engineering calculation, curve fitting techniques and statistical tools to determine and curve fit the relationship between trim time and trim amount” (page 4, lines 14-17 of the June 20, 2006 Office Action) fails to establish a *prima facie* case of obviousness because even assuming such a modification would have been obvious, which Applicants do not concede, the modification would not include all the claim limitations, in particular the relationships recited in claims 1, 8 and 9. The Examiner’s determination that one of ordinary skill’s application of commonly used engineering calculations, curve fitting techniques, and statistical tools would somehow result in the exact relationships recited in claims 1 and 8 is either an incredible coincidence or an impermissible hindsight reconstruction of the claimed invention. The undersigned respectfully submits it is the latter.

It is further respectfully submitted that the Examiner’s reliance on the “evidence” of Wadsworth fails to cure the deficiencies noted above with respect to Tomoyasu et al. Wadsworth also fails to disclose or suggest, at least, the relationships recited in claims 1, 8 and 9. Therefore, even assuming it would have been obvious to combine Tomoyasu et al. and Wadsworth, which Applicants do not concede, the combination would not include all the claim limitations and would not present a *prima facie* case of obviousness.

The Examiner’s reliance on Natzle et al., as evidenced by Wadsworth, suffers the same flaws as the reliance on Tomoyasu et al. Even assuming it would have been obvious for one of ordinary skill in the art, after gathering information, to tabulate/extrapolate/manipulate data and perform calculation using common statistical methods, which Applicants do not concede, such a modification would not include all the claim limitations, in particular the relationships recited in claims 1, 8 and 9. Moreover, as discussed above, any conclusion that such a modification would somehow result in the relationships recited in claims 1, 8 and 9 is either entirely coincidental, or hindsight.

As also discussed above, the Examiner’s reliance on the evidence of Wadsworth is insufficient to overcome the deficiencies of Natzle et al. and even assuming it would have been obvious to combine the references, which Applicants do not concede, such a

combination would not include all the claim limitations and would not present a *prima facie* case of obviousness.

It is further respectfully submitted that Doris et al. fail to cure the deficiencies of Natzle et al. with respect to claim 1 and that even assuming it would have been obvious to combine the references, which Applicants do not concede, such a combination would not include all the claim limitations and would not present a *prima facie* case of obviousness.

Respectfully submitted,

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